

### **REMARKS**

Applicants respectfully request reconsideration of the present application in view of the following remarks. Prior to entry of this response, claims 28-54 were pending in the application, of which claims 28 and 46 are independent. In the Office Action mailed November 6, 2006, the Examiner rejected claims 28-29, 35-37, 39, and 41-45 under 35 U.S.C. § 102(b) and claims 30-34, 38, 40, and 46-54 under 35 U.S.C. § 103(a). Following this response, claims 28-54 remain pending in this application. Applicants hereby address the Examiner's objections and rejections in turn.

#### **I. Objections to the Drawings**

The Examiner objected to Figure 2a, stating that it lacks proper cross-hatching indicating the type of materials comprising the embodiment of the invention depicted in Figure 2a. Applicants submit the attached replacement Figure 2a, addressing the Examiner's objection. Applicants also submit the attached annotated drawing sheet reflecting the changes made in replacement Figure 2a. Applicants believe the replacement Figure 2a overcomes the Examiner's objection and requests approval of the replacement figure.

#### **II. Rejection of the Claims Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 28-29, 35-37, 39, and 41-45 under 35 U.S.C. § 102(b) as being anticipated by German Patent Number 27 10620 ("Siewerth"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Because Siewerth does not teach every element recited in claim 28, it does not anticipate claim 28 or any of dependent claims 29, 35-37, 39, or 41-45.

Claim 28 recites, among other things, “electrical contact elements electrically connecting said base and said cover, wherein said electrical contact elements are selected from the group of metal fusion joints and resilient members suitable to penetrate said ferromagnetic material.” The Examiner asserts that Siewerth teaches the claimed “electrical contact elements electrically connecting said base and said cover” at page 6, without pointing to any portion of that page. Siewerth’s page 6 includes a brief description of Siewerth’s figures and a detailed description of Figure 1. Nothing in either the brief description of the figures or the detailed description of Figure 1 teaches electrically connecting the base and cover shown in Figure 1 with electrical contact elements, let alone a metal fusion joint or a resilient member suitable to penetrate ferromagnetic material. At most, Siewerth discloses that individual bars 5 making up the base can be joined at their intersection points. But that disclosure does not teach electrical contact elements electrically connecting said base and said cover, much less using either a metal fusion joint or a resilient member suitable to penetrate ferromagnetic material. Lacking such disclosure, Siewerth cannot anticipate claim 28.

Not only does Siewerth fail to disclose the claimed “electrical contact elements,” the Examiner has not identified a sufficient disclosure in Siewerth of a base electrically connected to a cover. The Examiner points to Figure 1, but that figure does not show the base electrically connected to the cover—the angle of the oblique view depicted in Figure 1 merely shows that the cover is positioned above the base, but does not reveal whether they are connected. Instead, it is Siewerth’s Figure 3 that depicts the structural

relationship between the base and cover shown in Figure 1, and that figure clearly shows that the cover is not electrically connected to the base—indeed, there is a gap, depicted by the number 9, between the cover and the base. Siewerth's written description also makes clear that, while the cover is positioned over the base, the base and cover shown in Figure 1 are not electrically connected: "[t]he shielding effect of the cage 1 is not lost if a gap 9 left between it and the top covers 4 is not filled with ferromagnetic material, as illustrated in Figure 3." Siewerth at 7 (emphasis added).

The Examiner points to Siewerth's statement that "[t]he top covers need only be placed on top of the cage 1," but this statement is made in the context of Siewerth's explanation that there is no connection between the base and the cover shown in Figures 1 and 3. *Id.* A reference to "on top of" does not disclose that the base and the cover are electrically connected, as recited in claim 28. Rather, consistent with Figures 1 and 3, "on top of" plausibly refers to the top cover simply being "over" or "above" the base. Thus, the Examiner has not identified a disclosure of Siewerth's base and cover being electrically connected, and certainly not with "electrical contact elements" "selected from the group of metal fusion joints and resilient members suitable to penetrate said ferromagnetic material."

Accordingly, Siewerth does not teach or suggest each limitation of claim 28, and Applicants respectfully request that the rejection of claim 28 be withdrawn. Because claims 29, 35-37, 39, and 41-45 depend from claim 28, Applicants request that the rejection of those claims also be withdrawn.

With further respect to claim 29, the Examiner contends that Figure 1 of Siewerth teaches a base and a cover having superimposed on either side of the conduit, without

pointing to any particular element or portion of Figure 1. The Examiner further contends that Siewerth teaches electrical contact elements applied to the superimposed portions at page 6. Figure 1 does not appear to show a base having superimposed portions on other side of the conduit, nor does page 6 teach electrical contact elements joined to superimposed portions. If the Examiner believes otherwise, Applicant requests that the Examiner clarify the rejection so that Applicant can understand its basis.

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

The Examiner rejected claims 31-34, 38, 40, 46-51, and 53-54 under 35 U.S.C. § 103(a) as being obvious over Siewerth. In order to establish a *prima facie* case of obviousness, the cited reference must teach or suggest each of the claimed limitations. Each of claims 31-34, 38 and 40 depend from claim 28 and include its limitations. Claim 28 recites, among other things, "electrical contact elements electrically connecting said base and said cover, wherein said electrical contact elements are selected from the group of metal fusion joints and resilient members suitable to penetrate said ferromagnetic metals." Siewerth does not teach or suggest this limitation.

Furthermore, Siewerth provides no motivation to modify its teachings to include this feature. As the Examiner acknowledges in the November 6<sup>th</sup> Office Action, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the cited reference to meet the claimed invention. OA at 12. Here, the cited combination does not suggest modifying the disclosure of Siewerth to make the claimed invention. Instead, Siewerth expressly teaches away from Applicant's claimed "electrical contact elements electrically connecting said base and said cover":

There is no need to provide a fixed connection between the top covers 4 and the cage 1, such as welding. Similarly, the top covers 4 do not need to be in close contact with the cage 1 in order for the protection system to operate at its optimum effect. The shielding effect of cage 1 is not lost if a gap 9 is left between it and the top covers 4 is not filled with ferromagnetic material.

Siewerth at 7; see *also* Fig. 3.

Thus, Siewerth expressly discourages an electrical connection between the cover and the base. Because Siewerth teaches away from Applicant's claimed invention, it would not have been obvious to modify Siewerth's teaching in the manner suggested by the Examiner. MPEP 2141.02. Accordingly, a *prima facie* case of obviousness has not been established with claims 31-34, 38, or 40, each of which depend from claim 28. Applicants therefore respectfully request that the rejection of those claims be withdrawn.

With regard to claim 46, the Examiner acknowledges that Siewerth does not disclose the following recitation of claim 46: "providing an electrical connection between said base and said cover having a conductance, per meter of length, of at least 150 Siemens/m." The Examiner asserts that it would have been obvious to one of ordinary skill to modify the disclosure of Siewerth to have a conductance between the cover and the base of a conduit of 150 Siemens/m. As discussed above, Siewerth does not teach or suggest an electrical connection between the base and the cover of a conduit. In fact, Siewerth states that "[t]here is no need to provide a fixed connection between the top covers 4 and the cage 1, such as welding." Siewerth at 7. This is illustrated in Siewerth's Figure 3, which confirms that no electrical connection exists between the cover and the base.

Accordingly, as Siewerth does not teach or suggest providing an electrical connection between the base and the cover of a conduit, and in fact teaches away from such a connection, a *prima facie* case of obviousness has not been established with regard to claim 46. Therefore, Applicants respectfully request that the rejection of claim 46, as well as dependent claims 47-51 and 53-54, as being obvious over Siewerth be withdrawn. Applicants note that arguments similar to those presented above in regard to the Examiner's rejection of claims 31-34, 38, 40, 46-51, and 53-54 over Siewerth were presented in Applicants' response to the June 19, 2006 Office Action. However, in the November 6<sup>th</sup> Office Action, the Examiner did not address these arguments.

With specific regard to the Examiner's rejection of dependent claim 50, the Examiner asserts that Siewerth discloses providing an electrical connection between the base and the cover of a conduit through a metal fusion between the base and the cover, citing page 6 of Siewerth. Applicants respectfully traverse the Examiner's assertion, however, as Siewerth merely teaches that sequential sections of the base may be joined to one another. Nothing in the cited passage teaches a metal fusion between the base and the cover. In fact, the passage of Siewerth cited by the Examiner expressly teaches that it is not necessary to provide metal fusion between the base and the cover of the conduit: "There is no need to provide a fixed connection between the top covers 4 and the cage 1, such as welding." Siewerth at 7. For this additional reason, Applicants request that the rejection of claim 50 be withdrawn.

The Examiner also rejected claims 30 and 52 under 35 U.S.C. § 103(a) as being obvious over Siewerth in view of German Patent Number 3,447,836A1 ("Fasterding"). The Examiner acknowledges that Siewerth does not disclose claim 30's recitation of

“wherein resilient members are clips provided with portions able to penetrate said ferromagnetic material,” but asserts that the abstract of Fasterding teaches this limitation. The Examiner also asserts that Fasterding teaches the similar limitation of claim 52 “wherein electrically coupling said lateral portions comprises applying to said lateral portions a plurality of metal resilient clips able to pierce the surface of said lateral portions under their elastic action.” However, while the abstract of Fasterding teaches a trough and lid formed of sheet steel, it does not teach or suggest that elements 6, best shown in Figure 2, form an electrical connection between the trough and the lid. Furthermore, the abstract of Fasterding does not disclose that the elements 6 comprise portions able to penetrate said ferromagnetic material as recited in claims 30 and 52. Accordingly, the combination of Siewerth and Fasterding does not teach or suggest each limitation of claims 30 and 52. This argument was presented in Applicant's response to the June 19, 2006 Office Action, but the Examiner provided no response.

In any case, Siewerth and Fasterding cannot properly be combined because Siewerth teaches away from the modification suggested by the Examiner. The Examiner states that there is “clearly” a motivation to modify the conduit of Siewerth with the contact elements of Fasterding, but did not explain where that motivation is found. Applicants respectfully traverse the Examiner's statement, particularly given that Siewerth affirmatively teaches away from such a modification. Siewerth teaches that “[t]here is no need to provide a fixed connection between the top covers 4 and the cage 1, such as welding. Similarly, the top covers 4 do not need to be in close contact with the cage 1 in order for the protection system to operate at its optimum effect.” Siewerth at 7; see *a/so* Fig. 3. In considering a prior art reference, the Examiner is required to

consider the reference as a whole, including portions that teach away from the suggested combination. MPEP 2141.02. Because Siewerth expressly teaches that it is not necessary to have a connection between the lid and the base of the conduit of the type disclosed by Fasterding, there is no motivation to modify Siewerth in the manner suggested by the Examiner. For these reasons, no *prima facie* case of obviousness has been established with regard to claims 30 or 52.

IV. Conclusion

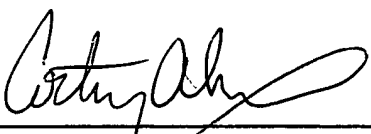
In view of the foregoing remarks and amendments, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims. The claims may include other elements not addressed herein that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to our deposit account.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 3, 2007

By:   
Cortney S. Alexander  
Reg. No. 54,778



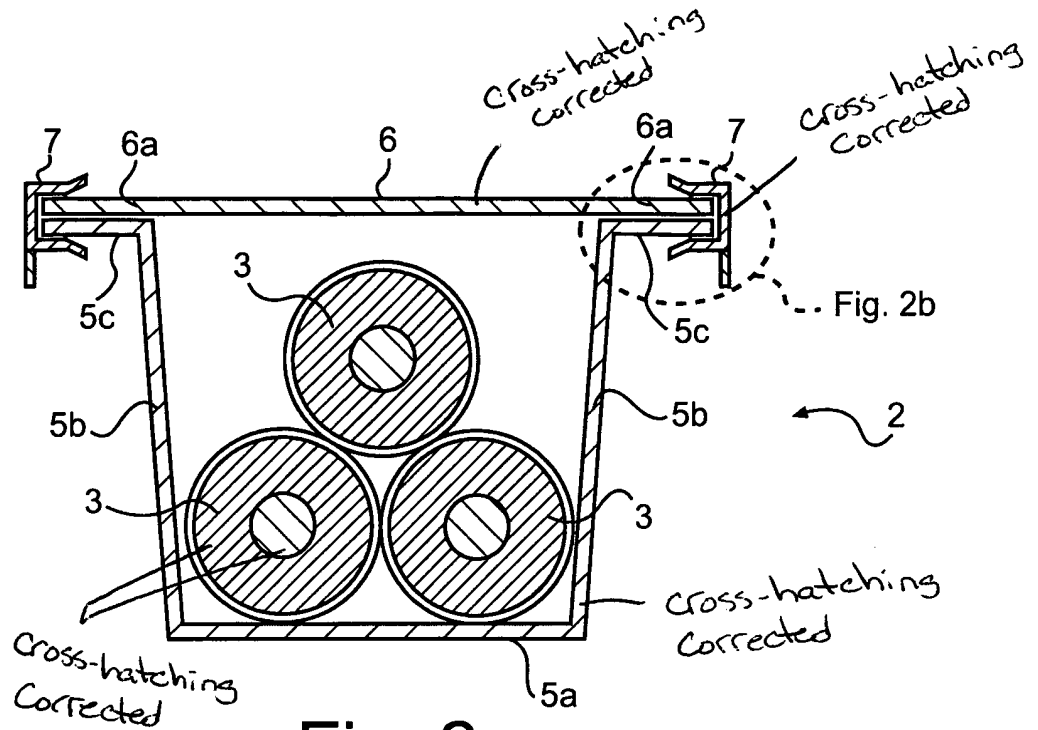


Fig. 2a

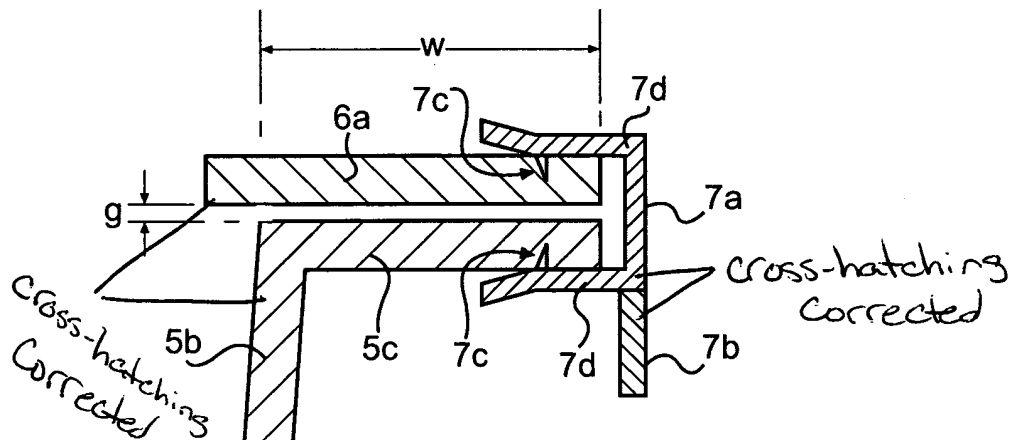


Fig. 2b

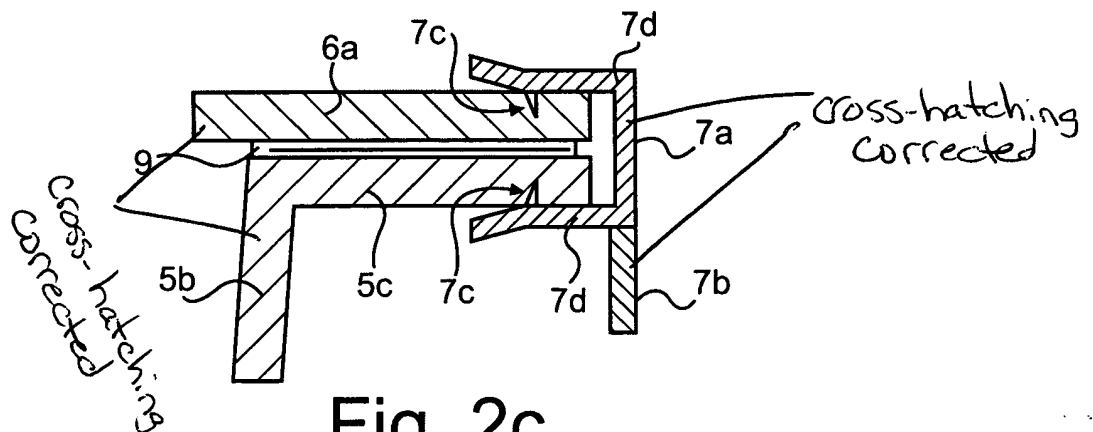


Fig. 2c